

REMARKS

In this Response, Applicant traverses the Examiner's rejection of the pending claims. Claims 7-10 and 27-70 are pending in this case, of which claims 7, 27, 31, 45, 49, 58, and 63 are independent claims.

In the Office Action mailed January 22, 2004, the Examiner rejected claims 7-10 and 27-70 under 35 U.S.C. § 103(a) as unpatentable over a web-page article entitled "Structured Notes" by R. Pemberton of Cansco Investment Counsel Ltd. ("*Pemberton*") in view of a web-page article entitled "Interest Rate Derivatives Real-Time Pricing System Financial Engineering and Software Systems for the Derivatives Market for Traders of Financial Derivatives Who Need Rapid Accurate Pricing" attributed to Layer Eight Systems, Inc. ("*Layer Eight*") and further in view of a web-page article entitled "An Investor's Guide to Mortgage Securities" ("*IGMS*") attributed to The Bond Market Association. Applicant traverses this rejection because none of these references can be relied upon as prior art to the Applicant's invention.

First, Applicant traverses the 35 U.S.C. § 103(a) rejection based on this combination of references because the *Pemberton* Internet article cannot be relied upon as prior art to the Applicant's invention. The Examiner has the burden of proving that all references relied upon in the Office Action are prior art. "Prior art disclosures on the Internet or on an on-line database are considered to be publicly available as of the date the item was publicly posted." (See MPEP § 2128). "If the publication does not include a publication date (or retrieval date), it cannot be relied upon as prior art under 35 U.S.C. § 102(a) or (b)." (See MPEP § 2128). Similarly, the Internet publication cannot be relied upon as prior art under 35 U.S.C. § 103(a). (See MPEP § 706.02). The

Examiner has provided no evidence, and indeed there is no evidence, of *Pemberton*'s publication date. (See Office Action at page 2 and accompanying Notice of Cited References form PTO-892). Based on the footer information on the hard copy of the *Pemberton* web-page provided by the Examiner, Applicant assumes the Examiner retrieved *Pemberton* on January 15, 2004. (See MPEP 707.05(e)). January 15, 2004, however, does not predate the filing date or the priority date of the present application, as Applicant filed the present application on September 18, 2000 and claims priority of Provisional Application No. 60/154,040, which was filed on September 16, 1999. Thus, *Pemberton* is not a legitimate prior art reference to the present application under MPEP § 2128.

Consequently, the Examiner has not made a *prima facie* case of unpatentability under 35 U.S.C. § 103(a). To make a *prima facie* case of unpatentability under 35 U.S.C. § 103(a), the Examiner must demonstrate that each and every element of Applicant's claimed invention is taught or suggested by prior art references. (See MPEP § 2143). In the Office Action, the Examiner uses *Pemberton* as the primary reference and alleges that *Pemberton* teaches several features of claims 7-10 and 27-70. Because *Pemberton* is not a legitimate prior art reference, the Examiner has failed to demonstrate that at least the elements allegedly disclosed by *Pemberton* are taught or suggested by the prior art. Accordingly, Applicants submit that claims 7-10 and 27-70 are allowable.

In addition, Applicant traverses the 35 U.S.C. § 103(a) rejection based on this combination of references because the *Layer Eight* and *IGMS* Internet articles cannot be relied upon as prior art to the Applicant's invention. The Examiner apparently

alleges that *Layer Eight*'s publication date is 1994. (See Office Action at page 2 and accompanying Notice of Cited References form PTO-892). The Examiner has not, however, provided any evidence that *Layer Eight* was publicly posted on the Internet in 1994, as required by MPEP § 2128. Examination of the *Layer Eight* reference reveals no indication that it was publicly posted on the Internet in 1994 or otherwise published in 1994. The only date on *Layer Eight* is a copyright notice dated 1994-1999. A copyright notice date of "1994-1999" does not evidence the date the item was "publicly posted" on the Internet, nor does it indicate which portions were copyrighted in 1994 and which portions were copyrighted in 1999 or the intervening years. Without evidence of a "publication date" as required by MPEP § 2128, it is impossible to tell whether, for example, the portions of the article relied upon by the Examiner were written on December 31, 1999, and then later posted on the Internet on December 31, 2003. The only evidence of publication date on the copy of *Layer Eight* provided by the Examiner is a footer indicating that it was apparently retrieved from the Internet on January 15, 2004. Accordingly, under MPEP § 2128, because the publication does not include a publication date (or a prefiling retrieval date), it cannot be relied upon as prior art against the present invention.

For similar reasons, the portions of the *IGMS* Internet article used in the section 103(a) rejection, which bear copyright notices dated 1999, cannot be relied upon as prior art against the present invention under MPEP § 2128. (Page 16 of *IGMS*, which bears copyright notices dated 1997 and 2000, was not cited or used in the rejection and does not teach or suggest any of the claimed features of the invention).

Moreover, even assuming *arguendo* that the relevant portions of *Layer Eight* were publicly posted on the Internet sometime in 1999, which is the date of the copyright notices, the Examiner has not provided evidence of a specific date that makes it prior art to the present application. The present application claims priority of Provisional Application No. 60/154,040, which was filed on September 16, 1999. To use it as prior art to the present application, the Examiner has the burden of providing evidence that *Layer Eight* was published before September 16, 1999. On the copy of *Layer Eight* provided, the copyright notices indicate only "1999" and do not indicate whether it was published before or after September 16, 1999, (again, assuming *arguendo* that it was actually posted on the Internet in 1999). (See MPEP § 706.02(a)).

For these additional reasons, the Examiner has not made a *prima facie* case of unpatentability under 35 U.S.C. § 103(a). In the Office Action, the Examiner uses both *Layer Eight* and *IGMS* as secondary references and alleges that they teach features of claims 7-10 and 27-70 not taught by *Pemberton*. Because neither *Layer Eight* nor *IGMS* were shown to be prior art references, the Examiner has failed to demonstrate that at least the elements allegedly disclosed by *Layer Eight* and *IGMS* are taught or suggested by the prior art. Accordingly, Applicants submit that claims 7-10 and 27-70 are allowable.

Furthermore, *Pemberton*, *Layer Eight*, and *IGMS* fail to teach or suggest, whether taken alone or in combination, several elements of the combination of elements recited in the pending claims. Accordingly, pending claims 7-10 and 27-70 are allowable for this additional reason.

Finally, Applicant notes that although the Office Action lists what each reference allegedly teaches, it does not explain the pertinence of each reference's teaching with regard to each of the specific features recited in the rejected claims, or even with regard to any particular claim among the 47 pending claims. (See MPEP § 706; 37 C.F.R. § 1.104). Consequently, it is extremely difficult to discern what the Examiner alleges is the correspondence between each of the claim features and the references.

In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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